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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/442,284 | 11/19/1999 | RAPHAEL F. MELOUL | MENLO-103-DI | 5637 |

7590 12/04/2003
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EXAMINER

MAIORINO, ROZ

ART UNIT PAPER NUMBER

3763

DATE MAILED: 12/04/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/442,284

Applicant(s)

MELOUL ET AL.

Examiner

Roz Maiorino

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-22, 38-40, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22 and 38-40, 42-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No.5425718 to Tay et al. or US Patent No.5522803 to Teissen-Simony

Both Tay and Teissen-Simony teach a catheter having a proximal and distal end usable in a system for intraluminal treatment of a selected site of a patient including a transfer device 16 having a central opening for receiving the catheter and for storing at least one treatment element and propelling the treatment element into a lumen in the catheter comprising a connector integral with the proximal end of the catheter including a detent for securing the connector in the central opening of the transfer device; the detent comprises a cantilever arm axially extending from the connector.

2. Claims 21, 42-43 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 5769868 to Yock.

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Yock teach a catheter with an elongated tube having a proximal and distal ends, first and second lumen extending between the proximal and distal ends and communication at the distal ends, the first lumen sized to receive a treatment element; Lumen having an elliptical crosses section. (Figure 5-8)

3. Claims 40 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4364376 to Bigham.

Bigham teaches a catheter with a shield tube fitted over a portion of the catheter for protection from the radioactive treating elements.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5769868 to Yock, and further in view of US Patent No. 6334064 to Fiddian-Green.

Yock teach a catheter with an elongated tube having a proximal and distal ends, first and second lumen extending between the proximal and distal ends and communication at the distal ends, the first lumen sized to receive a treatment element; Lumen having an elliptical crosses section. (figure 5-8)

However Yock does not teach lumen radiopaque marker. Fiddian- Green discloses a multilumen catheter with radiopaque marker

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined the two studies. Radiopaque markers are very common in the art, as stated in Fiddian-Green it will allow the care giver to be able to follow the exact position of the catheter once placed in side of the patient.

5. Claim 38-39 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5899882 to Waksman, and further in view of U.S Patent No. 6088610 to Littmann et al.

Waksman discloses an apparatus and method for delivery of a treating element, such as a radiation source, with multilumen catheter. Waksman, however, does not teach a lining that protects the lumen. Littmann teaches a lining inside the lumen for lubrication with ultimately allows for a smoother pass of the guidewire hence protecting the walls from damage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined the studies, because according to Littmann the lining allows for lubrication with ultimately allows for a smoother pass of the guidewire hence protecting the walls from damage.

Response to Arguments

6. Applicant's arguments with respect to claims 19-22, 38-43 are have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 703-305-2336. The examiner can normally be reached on 8:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

RM



MICHAEL J. HAYES
PRIMARY EXAMINER